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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/636,272 08/10/00 JUDGE

A 02755-000379

EXAMINER

TM02/0806

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TELLI

ART UNIT

PAPER NUMBER

2632

DATE MAILED:

08/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/636,272

Applicant(s)

JUDGE, ALFRED H.

Examiner

Julie Lieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2000.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-31 and 33-37 is/are rejected.
- 7) ☒ Claim(s) 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to the amendment filed May 29, 01. All original claims have been canceled. New claims 25-37 have been added.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 33, "said cavity" lacks antecedent basis. It appears that claim 33 should depend on claim 26. Correction or verification is required.

Claim Rejections - 35 USC § 103

1. Claims 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bein et al. (US Patent No. 4,703,315) in view of Jansky (US Patent No. 4,141,151).

Claims 25-26:

Bein et al. discloses a leveling mechanism comprising:

- a. a housing, a cavity in said housing (fig. 1)
- b. a rotating member 46 in said housing moving in the cavity such that the rotating member seeks an equilibrium position which corresponds to a horizontal or vertical plane;
- c. electrical contacts 52, 58 coupled with said rotating member and only completing an electrical circuit when said rotating member is in the equilibrium position;
- d. an indicator 30,32 electrically coupled with said electrical contacts for indicating to a user when the mechanism is in an equilibrium position; and
- e. A power source 18 coupled with said electrical contacts and said indicator for energizing said indicator when said electrical circuit is complete.

The level mechanism in Bein indicate whether the level condition is vertical or horizontal. As stated in col. 1, lines 9-11, it appears that the level indicating device in Bein is used with a workpiece, though it is not clear whether the work piece is a power tool or not. However, the use of a level condition indicating device in power tool, such as a portable electric power drill, comprising:

- a. a housing
- b. a motor within the housing
- c. an output coupled to the motor
- d. an activation member for energizing the motor for rotating the output

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is conventional in the art as shown in Jansky. Therefore, it would have been obvious to one skilled in the art to use the leveling device of Bein with the power tool of Jansky in place of the bubble leveling device in Jansky because the leveling devices are functionally equivalent and also the LED indicator would provides more visual effect than just a bubble since it could be recognized more clearly from a remote position than the bubble leveler.

Claim 27:

The rotating member 46 is being fixed for rotation about a center axis 48 in the cavity in said housing. The housing 11 is rectangular in shape. However, one skilled in the art would have readily recognized using an appropriate shape of a housing the for the leveling device in Bein depending on its application but the shape of the housing for the device would not alter the function of the leveling device.

Claim 28:

The rotating member 46 includes a biased electrical contact 52 or 58. Col. 6 lines 23-27.

Claim 29:

The electrical contacts in Bein is a pair of conductive members coupled with the housing. Each member includes electrical contact portions spaced 90 degrees from one another about the circuit such that as the rotating member reaches the equilibrium position, the rotating member biased electrical member contacts the annular rings electrical contact portions completing the circuit and activating the indicator. Figs. 1 and 3.

Claim 30:

The rotating member 46 could be manufactured from an electrically conducting material. Col. 5 lines 47-51.

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Claim 31:

The rotating member 46 is partially cylindrical. It is not totally cylindrical and does not have at least one projecting member. However, one skilled in the art would have readily recognized that the rotating member in Bein without the projecting member would be functionally equivalent with the claimed cylindrical rotating member.

Allowable Subject Matter

1. Claim 32 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. Claims 33-37 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Applicant's Remarks

The applicant has argued that there is no motivation or suggestion to combine Bein with Jansky and the examiner is utilizing hindsight in an attempt to combine the two references.

Response to Applicant's Remarks

Applicant's arguments filed May 29, 01 have been fully considered but they are not persuasive.

Regarding suggestion or motivation in the references to combine the two cited prior arts to Bein and Jansky, and examiner's attempt to use hindsight, refer to Bein, background of the invention section.

The suggestion or motivation is stated in Bein that a leveling device is conventionally used in a workpiece and also in Jansky, a leveling device is clearly shown used in a powered workpiece. It would have been obvious to one skilled in the art to readily recognize combining the teachings of these two references for the reason stated in the rejection above and in light of suggestion made in both references.

Further, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

Regarding the applicant's assertion that the examiner has attempted to make a hindsight reconstruction, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was

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made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Lieu whose telephone number is 703-308-6738. The examiner can normally be reached on Mon-Thurs, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass can be reached on 703-305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Julie Lieu
Primary Examiner
Art Unit 2632

jl
July 31, 2001